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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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William Shepler

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EXAMINER

MCKINLEY, CHRISTOPHER BRIAN

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/726,044	Applicant(s) SHEPLER ET AL.	
	Examiner Christopher B. McKinley	Art Unit 3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 13-21 and 27-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-10, 22-24 and 26 is/are rejected.
- 7) ☐ Claim(s) 11, 12 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species: a container along with a lid, a method for making the container and lid by way of extrusion blow molding and an apparatus, more specifically a die as a means to produce varying thickness in the walls of the container and lid. The species are independent or distinct for the following reasons.
2. The container lid product and method for making thereof are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make another and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the container, lid combination can be made through different processes (i.e. injection molding). Conversely, extruded blow molding is often times used to make a variety of different shaped containers as well as bottles.
3. The container, lid combination and the die are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a materially different product or (2) that the product as claimed can be made by another and materially different

apparatus (MPEP § 806.05(g)). The apparatus as claimed is not an obvious apparatus for making the product and the apparatus as claimed can be used to make a different product such as the container, lid combination can be made without the use of a die (i.e. stretch blow molding). Conversely, the die can be used to make a variety of different shaped containers as well as bottles.

4. The process for making the container and the die are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the die can be used in a different process making other items (i.e. bottles with varying wall thickness). Conversely, the process by which the die is used can be carried out using different a different apparatus (i.e. different shaped die).

5. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

6. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there are no generic claims.

7. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim

is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

8. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species.

MPEP § 809.02(a). During a telephone conversation with Andrew Lawrence on August 10, 2006 a provisional election was made without traverse to prosecute the invention of the container and lid, claims 1-12 and 22-26. Affirmation of this election must be made by applicant in replying to this Office action. Claims 13-21 and 27-30 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

9. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 2, 3, 4, 8, 9, 10, 22, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Young (3,339,776). Young ('776) discloses the same invention (see fig. 1) including a container portion comprising a bottom panel (23) connected to and disposed between two opposing bottom side corner sections (24) and two opposing bottom end corner sections (25), each bottom side corner section connecting the bottom panel to one of two opposing side panels, each bottom end corner section connecting the bottom panel to one of two opposing end panels, each side panel being disposed between and connected to the end panels by one of four vertical corner sections (20, 21, and 22) to form an open top box structure with an interior cargo space and a continuous upper rim (19), the four vertical corner sections having an average thickness greater than an average thickness of at least one of the end panels or the side panels (20, 21, and 22).

Regarding claim 2, the four vertical corner sections (fig.1, numbers 20, 21, and 22) have an average thickness greater than an average thickness of the side panels (10) and an average thickness of the end panels (16).

Regarding claim 3, the four vertical corner sections (fig.1, numbers 20, 21, and 22) have an average thickness greater than an average thickness of the bottom panel (23).

Regarding claim 4, the average thickness of the four vertical corner sections (fig.1, numbers 20, 21, and 22) is less than an average thickness of four bottom corner junctions where each vertical corner sections meets one of the bottom end corner sections and one of the bottom side corner sections (26).

Regarding claims 8 and 22, a lid (fig. 1) comprising a top panel (21) disposed between and connected to two opposing top side corner sections and two opposing top end corner sections, each top side corner section connecting the top panel to one of two opposing top side panels (24), each top end corner section connecting the top panel to one of two opposing top end panels (25), each top side panel being disposed between and connected to the top end panels by one of four top vertical corner sections to form a continuous rim for engaging the upper rim of the container portion, the four vertical top corner sections having an average thickness greater than an average thickness of at least one of the top end panels or top side panels (8 and 27).

Regarding claims 9 and 23, the four vertical top corner sections (8 and 27) have an average thickness greater than an average thickness both the top end panels (25) and top side panels (24).

Regarding claims 10 and 24, the average thickness of the top vertical corner sections (8 and 27) is greater than an average thickness of the top panel (21).

12. Claims 1, 5, 22 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Knieriem et al. (2,773,624).

Regarding claims 1 and 22, Knieriem et al. ('624) discloses the same invention including a storage container (fig. 1) comprising a bottom panel (25) connected to and disposed between two opposing bottom side corner sections and two opposing bottom end corner sections, each bottom side corner section connecting the bottom panel to one of two opposing side panels (fig. 2, 21), each bottom end corner section connecting the bottom panel to one of two opposing end panels (fig. 3, 22), each side panel being

disposed between and connected to the end panels by one of four vertical corner sections to form an open top box structure with an interior cargo space and a continuous upper rim (30), the four vertical corner sections (fig. 7, 32) having an average thickness greater than an average thickness of at least one of the end panels or the side panels. It should be noted that both the container from claim 1 and lid from claim 22, as claimed, have the same structure. Moreover the container from claim 1 can be a lid, i.e. inverted covering either a flat or elevated surface.

Regarding claims 5 and 26, a comparison of the recited process with the prior art processes does NOT serve to resolve the issue concerning patentability of the product. In re Fessman, 489 F2d 742, 180 U.S.P.Q. 324 (CCPA 1974). Whether a product is patentable depends on whether it is known in the art or it is obvious, and is not governed by whether the process by which it is made is patentable. In re Klug, 333 F2d 905, 142 U.S.P.Q. 161 (CCPA 1964). In an ex parte case, product-by-process claims are not construed as being limited to the product formed by the specific process recited. In re Hirao et al., 535 F2d 67, 190 U.S.P.Q. 15, see footnote 3 (CCPA 1976).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Knieriem ('624) in view of Krafft et al. (6,713,029). Knieriem et al. ('624) discloses the invention substantially as claimed, described in paragraph 12, excluding handles with a greater average thickness than the side and end panels. However, Krafft et al. ('029) teaches handles with a greater average thickness than the side and end panels for the purpose of distributing the weight of the tray over a greater area of the users fingers to provide a more comfortable grip (column 2, line 21). Therefore it would have been obvious to one having ordinary skill in the art at the time of invention to have modified Knieriem ('624) with handles with a greater average thickness than the side and end panels in order to distribute the weight of the tray over a greater area of the users fingers providing a more comfortable grip.

Allowable Subject Matter

15. Claims 11, 12 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher B. McKinley whose telephone number is (571) 272-3370. The examiner can normally be reached on 7:00 AM - 3:30 AM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571) 272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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NATHAN J. NEWHOUSE
SUPERVISORY PATENT EXAMINER